D. REMARKS

Interview Summary

On September 3, 2004, Applicants' representative submitted an "Applicant Initiated Interview Form" to Examiner Barry Taylor via facsimile. Applicants' representative requested discussion of a proposed attached amendment to claim 1 and requested clarification of claims 14 and 15.

On September 7, 2004 at 8:00 AM EST, an interview was conducted via telephone between Amy Pattillo, Applicants' Representative, and Examiner Barry Taylor. No exhibits were shown, nor demonstrations conducted.

Applicants' representative and the Examiner discussed claim 1, and in particular a proposed attached amendment to claim 1. Specifically, the prior art cited against claim 1 is the US Patent to Morganstein (US Patent Number 5,724,408) in view of Kuhn et al. (US Patent Number 6,724,866, hereinafter Kuhn).

In particular, Applicant's representative proposed an amendment in advance to add to "detecting a context for a call from a first party to a second party via a particular line" an additional element to claim 1 of "wherein a third makes telephone service available to said first party for said call" and where the context based criteria is "specified by said third party" to distinguish claim 1 from Morganstein in view of Kuhn. The Examiner pointed out that the third party could read on PBX systems, which would require an additional search. In addition, the Examiner pointed out that the terms context and criteria need to be narrowed. Applicants' representative agreed to consider additional amendments to clarify the meaning of context and criteria. In conclusion, no agreement with respect to the claims was reached. Applicants are filing this response with the amended claims for further review by the Examiner.

Specification

Applicants have amended the specification above to include the application serial numbers of the related cross-references.

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37 CFR 1.131 Affidavit

The Examiner cites Kuhn et al (US Patent 6,724,866) as prior art in the rejection of claims 1-54 under 35 USC 103(a). "Before answering *Graham's* 'content' inquiry, it must be known whether a patent or publication is in the prior art under 35 U.S.C. § 102." *Panduit Corp. v. Dennison Mfg. Co.,* 810 F.2d 1561, 1568, 1 USPQ2d 1593, 1597 (Fed. Cir.), *cert. denied,* 481 U.S. 1052 (1987). Subject matter that is prior art under 35 U.S.C. 102 can be used to support a rejection under section 103. *Ex parte Andresen,* 212 USPQ 100, 102 (Bd. Pat. App. & Inter. 1981). When the reference is not a statutory bar under 35 U.S.C. 102(b), (c), or (d), applicant can overcome the rejection by swearing back of the reference through the submission of an affidavit under 37 CFR 1.131. In re Foster, 343 F.2d 980, 145 USPQ 166 (CCPA 1965).

First, the reference is not a statutory bar under 102(b). 35 U.S.C. 102(b) requires: the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States. Kuhn's filing date is February 8, 2002. The filing date for the present invention is February 21, 2002. Since Kuhn's filing date does not precede the filing date of the present invention by more than 1 year, Kuhn does not create a statutory bar under 102(b).

Second, the reference is not a statutory bar under 102(a) or any other section of 102. Section (a) of 37 CFR 1.131 requires that when any claim of an application is rejected, the inventor of the subject matter of the rejected claim or the party qualified under sections 1.42, 1.43 or 1.47, may submit an appropriate oath or declaration to establish invention of the subject matter of the rejected claim prior to the effective date of the reference on which the rejection is based. In addition, section (b) of 37 CFR 1.131 requires "the showing of facts shall be such, in character and weight, as to establish reduction, or conception of the invention prior to the effective date of the reference coupled with due diligence from prior to said date to a subsequent reduction to practice or to the filing of the application." Applicants file an affidavit signed by the inventors with this paper in compliance with 37 CFR 1.131 states facts that show that prior to

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February 8, 2002, the inventors had completed the conception of the subject matter of rejected claims 1-54. A copy of the disclosure submitted by the inventors which includes drawings of a model of the invention. In addition, as the dates show, Applicants followed the conception of the subject matter prior to the invention date with reasonable diligence by filing the application for a patent only 13 days after the effective reference date.

Therefore, because Kuhn cannot be used as prior art under 102, Kuhn also cannot be used as prior art under 103. Applicants respectfully request allowance of claims 1-54 which are rejected under Morganstein in view of Kuhn. In addition, Applicants respectfully request allowance of newly added claims 55-65, as dependent of independent claims within 1-54.

35 USC § 103(a)

Applicants submit that Kuhn cannot be prior art cited against the present invention, however, in the event that Kuhn continues to be cited against the present invention, Applicants present the following arguments and amendments in response to the rejections based on 35 USC 103(a).

Claims 1-54

Claims 1-54 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Morganstein (US Patent Number 5,724,408) in view of Kuhn et al. (US Patent Number 6,724,866, hereinafter Kuhn). The Examiner carries the burden of proving a prima facie case of obviousness for a 103(a) rejection, as amended, claims 1-54 are not obvious in view of Morganstein in view of Kuhn and therefore the rejection should be withdrawn and the claims allowed.

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Claims 1, 6, and 11

Claim 1 currently reads:

1.(**Currently Amended**) A method for regulating calls, comprising:

detecting a context for a call from a first party to a second party via a
particular line, wherein a third party subscribes to a telephone service made
available to said first party for said call;

comparing said context for said call with a selection of context based
criteria for said particular line specified by said third party; and

only establishing a communication channel between said first party and
said second party through said particular line if said context is acceptable within
said selection of context based criteria.

In establishing a prima facie case of obviousness under 103(a), the combined prior art
references must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.3d 488, 20
USPQ2d 1438 (Fed Cir. 1991). The Examiner cites Morganstein as teaching "detecting a
context for a call from a first party to second party (abstract, col. 3 lines 27-32, col. 3 line 33-col.
4 line 63, col. 6 lines 24-65, col. 6 lines 4-12, col. 6 lines 47-50, col. 7 line 13-col. 8 line 54, col.
9 lines 27-58)", "comparing the context for the call with a selection of context based criteria for
particular line (abstract, col. 3 lines 27-32, col. 3 line 33-col. 4 line 63, col. 6 lines 24-65, col. 6
lines 4-12, col. 6 lines 47-50, col. 7 line 13-col. 8 line 54, col. 9 lines 27-58)", and "only
establishing a communication channel between the first party and second party through the
particular line if the context is acceptable within the selection of context based criteria (abstract,
col. 3 lines 27-32, col. 3 line 33-col. 4 line 63, col. 6 lines 24-65, col. 6 lines 4-12, col. 6 lines
47-50, col. 7 line 13-col. 8 line 54, col. 9 lines 27-58)." [Office Action, pp. 2-3] The Examiner

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notes, however, that Morganstein does not explicitly show regulating calls. The Examiner notes that Kuhn cites Morganstein "wherein call screener used to elicit speech from incoming caller whereby the telephony system routes calls based on comparison of the elicited speech to a set of stored speaker models (abstract). Kuhn discloses that the context for call may be used to determine "company affiliation" of caller (columns 1-2). Kuhn further shows context used to determine different classes of callers whereby different actions to be taken (col. 2 lines 34-64, col. 3 lines 3-4). Kuhn even discloses regulating based upon time context (col. 4 lines 37-63). Kuhn allows for dynamic context information as well. For example, if user wants to regulate calls from a rare coin vendor, the user simply creates context information to be used to regulate "coin vendors" (col. 4 line 19-col. 5 line 63)." [Office Action, p. 3] Thus, the Examiner concludes that it would have been obvious for anyone of ordinary skill in the art at the time of invention to "modify the processor as taught by Morganstein to use context based criteria as taught by Kuhn for the benefit of allowing user to dynamically select desired call context to be used as filtering criteria as taught by Kuhn." [Office Action, pp. 3-4]

Applicants amend claim 1 to indicate that a third party telephone service subscriber makes the telephone service used by the first party placing the call (See Specification p 7, lines 6-8). In contrast, Kuhn only describes a server system or the recipient telephone routing telephone calls based on information provided by the caller. [Col. 2 lines 31-33; Col. 2 lines 53-55: "Compared with existing systems, the invention has the advantage that calls from unwelcome people do no consume any of the recipient's time.] Kuhn describes the invention as giving the user "the capability to "hire" an automatic secretary who will screen their calls and respond to them appropriately." [Col. 2, lines 60-64] Kuhn, however, does not describe a third party telephone service subscriber making the telephone service used by the first party available for placing the call and allowing that third party telephone service subscriber to set the context based criteria used to determine whether a communication channel between the first party and the second party is allowed. Therefore, Applicants respectfully assert that amended claim 1 is not taught or suggested by Morganstein in view of Kuhn.

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Claim 3 originally included the element of "determining said selection of context based criteria from among a plurality of third party context based criteria." In particular, the Examiner cites col. 4 lines 64-col. 5, line 7 as teaching claim 3 in that the "user is able to define any type of criteria to be used as context thereby filtering telephone calls" Applicants note that amended claim 1 is distinguishable from dependent claim 3 because the third party telephone subscriber, and not the user, is the one setting the context based criteria.

Therefore, in view of the amendments made to overcome the Examiner's prima facie case of obviousness, Applicants respectfully request allowance of method claim 1 and corresponding system and program claims 6 and 11.

Claims 2, 4, 7, 9, and 12

Regarding claims 2, 4, 7, 9, and 12, Applicants respectfully propose that because Morganstein in view of Kuhn no longer anticipates the independent claims 1, 6, and 11 upon which these dependent claims rely, then Morganstein in view of Kuhn does not anticipate these dependent claims 2, 4, 7, 9, and 12 and the dependent claims should be allowed.

Claims 3, 8, and 13

Claims 3, 8, and 13 are deleted.

Claims 14 and 15

Claim 14 currently reads:

14.   (Original) A method for regulating outgoing calls, comprising:

detecting an identity of a party called via a particular line;

determining a selection of third party criteria governing calls via said particular line according to said identity of said called party; and

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only establishing a communication channel via said particular line between a calling party and called party if said called party is acceptable within said selection of third party criteria.

The Examiner notes that Kuhn cites Morganstein "wherein call screener used to elicit speech from incoming caller whereby the telephony system routes calls based on comparison of the elicited speech to a set of stored speaker models (abstract). Kuhn discloses that the context for call may be used to determine "company affiliation" of caller (columns 1-2). Kuhn further shows context used to determine different classes of callers whereby different actions to be taken (col. 2 lines 34-64, col. 3 lines 3-4). Kuhn even discloses regulating based upon time context (col. 4 lines 37-63). Kuhn allows for dynamic context information as well. For example, if user wants to regulate calls from a rare coin vendor, the user simply creates context information to be used to regulate "coin vendors" (col. 4 line 19-col. 5 line 63)." [Office Action, p. 5] Thus, the Examiner concludes that it would have been obvious for anyone of ordinary skill in the art at the time of invention to "modify the processor as taught by Morganstein to use context based criteria as taught by Kuhn for the benefit of allowing user to dynamically select desired call context to be used as filtering criteria as taught by Kuhn." [Office Action, p. 5]

With regard to claim 14, in establishing a prima facie case of obviousness under 103(a), the combined prior art references must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.3d 488, 20 USPQ2d 1438 (Fed Cir. 1991). Kuhn only discloses a call screening system that detects the caller's identity and routes the call according to filtering rules for the caller's identity. Kuhn focuses on routing based on the identity of the caller; Kuhn does not teach detecting the actual identity of the party answering the call, selecting criteria based on the actual identity of the party answering the call, and routing the call based on the criteria. In contrast, claim 14 teaches detecting the identity of the called party, selecting criteria according to the identity of the called party and only establishing a communication channel if the identity of the called party is acceptable within the criteria. Thus, Applicants respectfully assert that Kuhn does not teach or suggest the limitations of claim 14 and therefore the rejection should be removed

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and the claims allowed. In addition, Applicants respectfully note that the Examiner's rejection of claim 14 does not show how Kuhn teaches or suggests each element of claim 14.

Claim 15 is deleted.

Claims 16, 19, and 22

Claim 16 currently reads:

16. **(Currently Amended)** A method for screening calls, comprising:

detecting a context for a call from a first party to a second party, <u>wherein said context indicates at least one from among a location of said first party, a type of telephony device used by said first party, and a device used to authenticate an identity of said first party</u>; and

· responsive to said context requiring prescreening of said call, transferring said call to a screening party.

The Examiner cites Morganstein as teaching "detecting a context for a call from a first party to second party (abstract, col. 3 lines 27-32, col. 3 line 33-col. 4 line 63, col. 6 lines 24-65, col. 6 lines 4-12, col. 6 lines 47-50, col. 7 line 13-col. 8 line 54, col. 9 lines 27-58)", "comparing the context for the call with a selection of context based criteria for particular line (abstract, col. 3 lines 27-32, col. 3 line 33-col. 4 line 63, col. 6 lines 24-65, col. 6 lines 4-12, col. 6 lines 47-50, col. 7 line 13-col. 8 line 54, col. 9 lines 27-58)", and "only establishing a communication channel between the first party and second party through the particular line if the context is acceptable within the selection of context based criteria (abstract, col. 3 lines 27-32, col. 3 line 33-col. 4 line 63, col. 6 lines 24-65, col. 6 lines 4-12, col. 6 lines 47-50, col. 7 line 13-col. 8 line 54, col. 9 lines 27-58)." [Office Action, p. 6] The Examiner notes, however, that Morganstein does not explicitly show a call screener. [Office Action, p. 6] The Examiner notes that Kuhn cites Morganstein "wherein call screener used to elicit speech from incoming caller whereby the telephony system routes calls based on comparison of the elicited speech to a set of stored

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speaker models (abstract). Kuhn discloses that the context for call may be used to determine "company affiliation" of caller (columns 1-2). Kuhn further shows context used to determine different classes of callers whereby different actions to be taken (col. 2 lines 34-64, col. 3 lines 3-4). Kuhn even discloses regulating based upon time context (col. 4 lines 37-63). Kuhn allows for dynamic context information as well. For example, if user wants to regulate calls from a rare coin vendor, the user simply creates context information to be used to regulate "coin vendors" (col. 4 line 19-col. 5 line 63)." [Office Action, pp. 6-7] Thus, the Examiner concludes that it would have been obvious for anyone of ordinary skill in the art at the time of invention to "modify the processor as taught by Morganstein to use context based criteria as taught by Kuhn for the benefit of allowing user to dynamically select desired call context to be used as filtering criteria as taught by Kuhn." [Office Action, p. 7]

In establishing a prima facie case of obviousness under 103(a), the combined prior art references must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.3d 488, 20 USPQ2d 1438 (Fed Cir. 1991). Kuhn does not teach or suggest detecting the location of the first party (such as by GPS), the type of telephony device used by the first party (such as a cellular phone), or the device used to authenticate an identity of the first party (such as a third party authentication system). In contrast, claim 16 is amended to include the limitation that the context may include "at least one from among a location of said first party (p. 7 line 19), a type of telephony device used by said first party (p. 7 line 18), and a device used to authenticate an identity of said first party (p. 30 line 13)."

Therefore, in view of the amendments made to overcome the Examiner's prima facie case of obviousness, Applicants respectfully request allowance of method claim 16 and corresponding system and program claims 19 and 22.

Claims 17, 18, 20, 21, 23, and 24

Regarding claims 17, 18, 20, 21, 23, and 24, Applicants respectfully propose that because Morganstein in view of Kuhn no longer anticipates the independent claims 16, 19 and 22 upon

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which these dependent claims rely, then Morganstein in view of Kuhn does not anticipate these dependent claims 17, 18, 20, 21, 23, and 24_and the dependent claims should be allowed.

Claims 25, 35, and 45

Claim 25 currently reads:

25.   (**Currently Amended**) A method for regulating calls, comprising:

detecting an identity of a caller placing a call from a particular line number, wherein a third party independent of said caller subscribes for said particular line number;

accessing ~~third party~~ regulation criteria specified by said third party and relevant to said caller identity for said particular line number; and

regulating said call according to said relevant ~~third party~~ regulation criteria, such that a said third party is enabled to regulate calls to said particular line number without being a direct party to said call.

In establishing a prima facie case of obviousness under 103(a), the combined prior art references must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.3d 488, 20 USPQ2d 1438 (Fed Cir. 1991). The Examiner cites Morganstein as teaching "detecting a context for a call from a first party to second party (abstract, col. 3 lines 27-32, col. 3 line 33-col. 4 line 63, col. 6 lines 24-65, col. 6 lines 4-12, col. 6 lines 47-50, col. 7 line 13-col. 8 line 54, col. 9 lines 27-58)", "comparing the context for the call with a selection of context based criteria for particular line (abstract, col. 3 lines 27-32, col. 3 line 33-col. 4 line 63, col. 6 lines 24-65, col. 6 lines 4-12, col. 6 lines 47-50, col. 7 line 13-col. 8 line 54, col. 9 lines 27-58)", and "only establishing a communication channel between the first party and second party through the particular line if the context is acceptable within the selection of context based criteria (abstract, col. 3 lines 27-32, col. 3 line 33-col. 4 line 63, col. 6 lines 24-65, col. 6 lines 4-12, col. 6 lines

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47-50, col. 7 line 13-col. 8 line 54, col. 9 lines 27-58)." [Office Action, p. 9] The Examiner notes, however, that Morganstein does not explicitly show regulating calls. [Office Action, p. 9] The Examiner notes that Kuhn cites Morganstein "wherein call screener used to elicit speech from incoming caller whereby the telephony system routes calls based on comparison of the elicited speech to a set of stored speaker models (abstract). Kuhn discloses that the context for call may be used to determine "company affiliation" of caller (columns 1-2). Kuhn further shows context used to determine different classes of callers whereby different actions to be taken (col. 2 lines 34-64, col. 3 lines 3-4). Kuhn even discloses regulating based upon time context (col. 4 lines 37-63). Kuhn allows for dynamic context information as well. For example, if user wants to regulate calls from a rare coin vendor, the user simply creates context information to be used to regulate "coin vendors" (col. 4 line 19-col. 5 line 63)." [Office Action, pp. 9-10] Thus, the Examiner concludes that it would have been obvious for anyone of ordinary skill in the art at the time of invention to "modify the processor as taught by Morganstein to use context based criteria as taught by Kuhn for the benefit of allowing user to dynamically select desired call context to be used as filtering criteria as taught by Kuhn." [Office Action, p. 10]

Applicants amend claim 25 to indicate that a third party telephone service subscriber makes the telephone service used by the first party placing the call (See Specification p 7, lines 6-8). In contrast, Kuhn only describes a server system or the recipient telephone routing telephone calls based on information provided by the caller. [Col. 2 lines 31-33; Col. 2 lines 53-55: "Compared with existing systems, the invention has the advantage that calls from unwelcome people do no consume any of the recipient's time.] Kuhn describes the invention as giving the user "the capability to "hire" an automatic secretary who will screen their calls and respond to them appropriately." [Col. 2, lines 60-64] Kuhn, however, does not describe a telecommunication services that detects the third party telephone service subscriber making the telephone service used by the first party available for placing the call and allowing that third party telephone service subscriber to set the context based criteria used to determine whether a communication channel between the first party and the second party is allowed. Therefore,

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Applicants respectfully assert that amended claim 25 is not taught or suggested by Morganstein in view of Kuhn.

Applicants note that the Examiner rejects claim 29 (now deleted) which teaches "accessing said third party regulation criteria for a third party providing a line number utilized for said call" based on the last four lines of the abstract of Kuhn which teach "using call identification number to match incoming call." The scope of Kuhn's teaching of using the call identification number to match the incoming call is to identify the caller identity so that the call can be routed based on the caller's criteria for that incoming call line number. Applicants note that claim 25 is amended to indicate that the third party is the subscriber to the line number and that the third party actually sets the context criteria, rather than the receiving party. Thus, Applicants respectfully assert that Morganstein's teaching of using a call identification number to match an incoming call does not teach or suggest that a third party subscriber of the line used for the incoming call sets the criteria for routing the call.

In view of the amendments made to overcome the Examiner's prima facie case of obviousness, Applicants respectfully request allowance of method claim 25 and corresponding system and program claims 35 and 45.

Claims 26, 32, 33, 34, 36, 42, 43, 44, 46, 52, 53, and 54

Regarding claims 26, 32, 33, 34, 36, 42, 43, 44, 46, 52, 53, and 54, Applicants respectfully propose that because Morganstein in view of Kuhn no longer anticipates the independent claims 25, 35, and 45 upon which these dependent claims rely, then Morganstein in view of Kuhn does not anticipate these dependent claims 26, 32, 33, 34, 36, 42, 43, 44, 46, 52, 53, and 54 and the dependent claims should be allowed.

Claims 27, 28, 29, 37, 38, 39, 47, 48, 49

Claims 27, 28, 29, 37, 38, 39, 47, 48, 49 are cancelled.

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Claims 30, 31, 40, 41, 50, 51

Claims 30, 31, 40, 41, 50, 51 are amended to have proper antecedent basis reflective of the amendments to independent claims 25, 35, and 45.

Newly Added Claims

Applicants add claims 55-65 within basis in the specification. In particular, claim 55, which teaches "wherein said context comprises a location of said caller and a location of said callee", is taught on page 7, line 18. In addition, claim 56 which teaches "continually monitoring said context for said call once said communication channel is established between said first party and said second party, wherein said context for said call comprises an actual identity of said first party and an actual identity of said second party" and "only maintaining said communication channel between said first party and said second party if said continually monitored context is allowed when compared with said selection of context based criteria specified by said third party for said particular line" is taught on page 9, line 1-4. Claim 57 teaches a context which indicates a type of telephony device used by the first party (Specification, p. 7 line 18), claim 58 teaches a context which indicates a type of billing plan for telephony services available to said first party (Specification, p. 7 line 19), and claim 59 teaches a context which indicates a device that authenticates the identity of the first party (Specification, p. 30 line 13).

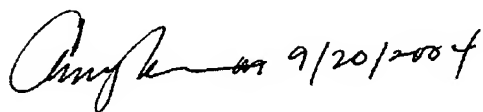AUS920010846US1   31

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Conclusion

Applicants note the citation of pertinent prior art cited by the Examiner.

In view of the foregoing, withdrawal of the rejections and the allowance of the current pending claims is respectfully requested. If the Examiner feels that the pending claims could be allowed with minor changes, the Examiner is invited to telephone the undersigned to discuss an Examiner's Amendment. Further, Applicants reiterate the request for a telephone conference with the Examiner at the Examiner's earliest convenience.

Respectfully submitted,

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